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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,833	12/24/2003	Hirokazu Sakai	247083US0	1127

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EXAMINER

PENG, KUO LIANG

ART UNIT PAPER NUMBER

1712

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/743,833

Applicant(s)

SAKAI ET AL.

Examiner

Kuo-Liang Peng

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/15/04 IDS.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10 is/are rejected.
- 7) ☒ Claim(s) 9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/15/04, 4/26/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details. The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-2, 5-7 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Cauwet (US 5 661 118).

Cauwet discloses a hair cleansing composition comprising at least one anionic surface-active agent, at least one amphoteric and/or zwitterionic surface-active agent, at least one polymer containing cationic groups, and at least one amphipathic amide lipid such as ceramide and/or glycoceramide. (col. 2, lines 1-13) The ceramide and/or glycoceramide is described in col. 10, line 25 to col. 12, line 58. A silicone can be used. (col. 8, lines 53-58, col. 14, lines 17-30 and Claim 24) The amount of the amphipathic amide lipid is described in col. 13, lines 5-8. Anionic surfactants such as sodium lauryl ether sulphate and/or sodium lauryl ether carboxylate can be used. (Examples) The amounts of anionic surfactants are described in col. 12, lines 62-64 and Examples.

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4. Claims 1-7 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Fack (FR 2819405), optionally as evidenced by WO 94/07844 (US 5 656 668), EP 646 572 (US 5 525 709), WO 95/16665 (US 5 476 671), FR 2 673 179 (US 5 618 523), EP 227 994, WO 94/24097 (US 6 210 691), EP 647 617 (US 5 665 778) and EP 736 522 (US 5 869 711).

The following paragraph numbers are based on its US equivalent, US 2004/0102354.

For Claims 1-4 and 10, Fack discloses a hair cleansing composition comprising at least one anionic surfactant, at least one amphoteric surfactant, at least one amphoteric polysaccharide chosen from celluloses, inulins and guar gums, and at least one water-insoluble conditioning agent chosen from: components A) to F). Component B) can be a silicone. Component F) can be a ceramide compound (an amphipathic amide lipid). ([0014]-[0022], [0281]-[0286] and Examples) Component F) can be those described in [0168] to [0196], including the ceramide compounds cited in WO 94/07844 (US 5 656 668), EP 646 572 (US 5 525 709), WO 95/16665 (US 5 476 671), FR 2 673 179 (US 5 618 523), EP 227 994, WO 94/24097 (US 6 210 691), EP 647 617 (US 5 665 778) and EP 736 522 (US 5 869 711), etc. All of these references are cited in Fack. Component B) is exemplified in [0069] to [0131], [150] to [153] and Examples.

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An anionic surfactant can be used. ([0135]-[0139]) For Claim 5, Fack teaches the use of the water-insoluble conditioning agent as a whole in an amount described in [0197]. Fack is silent on the specific individual amount for the ceramide compound. However, in view of the fact that the amount range of the total water-insoluble conditioning agent is substantially overlapped with that of the amphipathic amide lipid in the present invention. Examiner has a reasonable basis to believe that Fack's ceramide compound amount should fall within the amount range of the amphipathic amide lipid in the present invention.

For Claims 6-7, the anionic surfactant and the amount thereof are described in [0026]-[0032] and [0049].

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cauwet in view of Hardman (Silicones, Reprinted from Encyclopedia of Polymer Science and Engineering, vol. 15, 2nd Ed., Page 234) and alternatively in view of Polo (A Short Textbook of Cosmetology, 1998, pp. 65-69).

Cauwet discloses a hair cleansing composition, supra, which is incorporated herein by reference. Cauwet is silent on the specific use of a dimethylpolysiloxane. However, Hardman teaches that polydimethylsiloxane is the most commercially available silicones. (page 234, 2nd paragraph) Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize a polydimethylsiloxane in Cauwet's composition because it is commercially readily available, hence, economically favorable. Alternatively, Polo teaches the use of conditioners 4b), 5b) and 6b) in a hair care composition. (page 68) The motivation of using these conditioners is to achieve a desired hair conditioning effect. In light of the aforementioned benefit, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize Polo's conditioners in Cauwet' composition.

7. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cauwet.

Cauwet discloses a hair cleansing composition, *supra*, which is incorporated herein by reference. Cauwet is silent on the amount of silicone used. However, Cauwet teaches that the silicone can be used as a conditioning agent. As such, the amount of the silicone will affect the extent of hair conditioning. In other words, the amount of the silicone is a Result-Effective variable. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize the silicone in whatever amount through routine experimentation in order to achieve a desired hair conditioning effect. Especially, Applicants do not show the criticality of the amount of the silicone. See MPEP 2144.05 (II).

8. Claims 1-8 and 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoshino (US 6 685 953) in view of Polo.

For Claims 1-7, Hoshino discloses a hair cosmetic composition such as hair shampoo (i.e., cleansing) comprising an anionic surfactant and an amphithecium amide lipid represented by formulae (1) or (2). (col. 1, line 64 to col. 2, line 28, col. 7, lines 29-44 and col. 8, lines 6-14) Hoshino is silent on the use of a silicone. However, it is well known in the art to incorporate a conditioner into a hair shampoo composition. For example, Polo teaches the use of conditioning agents such as dimethicone, amodimethicone, etc. (Table 2-3) The motivation of using

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these conditioners is to achieve a desired hair conditioning effect. In light of the aforementioned benefit, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize Polo's conditioners in Hoshino's composition. The amount of the amphiphthic amide lipid is described in col. 7, lines 45-57. The anionic surfactant can be alkyl ether sulfate, etc. in an amount described in col. 8, lines 6-14. For Claim 8, note that the amount of the silicone as a conditioning agent will affect the extent of hair conditioning. In other words, the amount of the silicone is a Result-Effective variable. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize the silicone in whatever amount through routine experimentation in order to achieve a desired hair conditioning effect. Especially, Applicants do not show the criticality of the amount of the silicone. See MPEP 2144.05 (II). For Claim 10, Hoshino further teaches that the shampoo composition can contain an anionic surfactant as a "main active agent". (col. 8, lines 6-15) In other words, Hoshino teaches the use of other surfactants in addition to the anionic surfactant. Furthermore, Hoshino teaches that surfactants used can be anionic surfactants, cationic surfactants, nonionic surfactants or amphoteric surfactants. (col. 8, lines 6-15) In light of which, the other surfactants can only be chosen from cationic, nonionic and amphoteric surfactants. In view of the small size of the

specific genus disclosed by Hoshino, a prima facie case of obviousness is established. See MPEP 2144.08 II. A. 4(a). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize additional surfactant containing a nonionic surfactant, amphoteric surfactant and mixtures thereof with the expected success.

9. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fack.

Fack teaches the use of the water-insoluble conditioning agent as a whole in an amount described in [0197]. Fack is silent on the specific individual amount for the silicone. However, note that the amount of the silicone as a conditioning agent will affect the extent of hair conditioning. In other words, the amount of the silicone is a Result-Effective variable. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize the silicone in whatever amount through routine experimentation in order to achieve a desired hair conditioning effect. Especially, Applicants do not show the criticality of the amount of the silicone. See MPEP 2144.05 (II).

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10. Claim 9 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

None of the above references teaches or fairly suggests the specific weight ratio of the instant claim.

11. The related cases attached to the information disclosure statement filed on April 26, 2004 have been considered.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR

only. For more information about the PAIR system, see [http://pair-](http://pair-direct.uspto.gov)

[direct.uspto.gov](http://pair-direct.uspto.gov). Should you have questions on access to the Private PAIR system,

contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

klp

March 31, 2005



Kuo-Liang Peng
Primary Examiner
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